



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

37 CFR Part 1

[Docket No.: PTO-P-2014-0001]

RIN 0651-AC92

Changes to Continued Prosecution Application Practice

AGENCY: United States Patent and Trademark Office, Commerce.

ACTION: Final rule.

SUMMARY: The Leahy-Smith America Invents Act (AIA) revised and streamlined the requirements for the inventor's oath or declaration. In implementing the AIA inventor's oath or declaration provisions, the United States Patent and Trademark Office (Office) provided that an applicant may postpone the filing of the inventor's oath or declaration until allowance if the applicant provides an application data sheet indicating the name, residence, and mailing address of each inventor. The rules pertaining to continued prosecution applications (which are applicable only to design applications) require that

the prior nonprovisional application of a continued prosecution application be complete, which requires that the prior nonprovisional application contain the inventor's oath or declaration. The Office published an interim rule on March 5, 2014, to revise the rules pertaining to continued prosecution applications to permit the filing of a continued prosecution application even if the prior nonprovisional application does not contain the inventor's oath or declaration so long as the continued prosecution application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet indicating the name, residence, and mailing address of each inventor (continued prosecution application interim rule). The Office received no comments from the public in response to the continued prosecution application interim rule published on March 5, 2014. This final rule adopts as final the amendments to the rules of practice originally set forth in the continued prosecution application interim rule.

DATES: Effective Date: This final rule is effective on [Insert date of publication in the FEDERAL REGISTER]. The continued prosecution application interim rule published on March 5, 2014 at 79 FR 12384 was effective on March 5, 2014.

FOR FURTHER INFORMATION CONTACT: Eugenia A. Jones, Senior Legal Advisor, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, at (571) 272-7727.

SUPPLEMENTARY INFORMATION:

Executive Summary: Purpose: The previously published continued prosecution application interim rule permits the filing of a continued prosecution application even if the prior nonprovisional application does not contain the inventor's oath or declaration. See Changes to Continued Prosecution Application Practice, 79 FR 12384 (Mar. 5, 2014). The change in the continued prosecution application interim rule avoids the need for applicants to file the inventor's oath or declaration in an application in order to file a continued prosecution application of that application. This final rule adopts as final the amendments to the rules of practice originally set forth in the continued prosecution application interim rule.

Summary of Major Provisions: The previously published continued prosecution application interim rule provides that the prior nonprovisional application of a continued prosecution application that was filed on or after September 16, 2012, is not required to contain the inventor's oath or declaration so long as the prior nonprovisional application contains an application data sheet indicating the name, residence, and mailing address of each inventor. As discussed previously, this final rule adopts as final the amendments to the rules of practice originally set forth in the continued prosecution application interim rule.

Costs and Benefits: This rulemaking is not economically significant under Executive Order 12866 (Sept. 30, 1993).

Background: The Office revised the rules of practice pertaining to the inventor's oath or declaration during implementation of the AIA inventor's oath or declaration provisions to permit an applicant to postpone the filing of the inventor's oath or declaration until payment of the issue fee if the applicant provides an application data sheet indicating the name, residence, and mailing address of each inventor. See Changes To Implement the Inventor's Oath or Declaration Provisions of the Leahy-Smith America Invents Act, 77 FR 48776, 48779-80 (Aug. 14, 2012), and Changes to Implement the Patent Law Treaty, 78 FR 62367, 62376 (Oct. 21, 2013). The rules of practice pertaining to continued prosecution applications (which are applicable only to design applications) formerly required that the prior nonprovisional application of a continued prosecution application be a design application that is complete as defined by 37 CFR 1.51(b). See 37 CFR 1.53(d)(1)(ii) (2013) (required that the prior nonprovisional application of a continued prosecution application be a design application that is complete as defined by 37 CFR 1.51(b)). 37 CFR 1.51(b) in turn requires that an application contain the inventor's oath or declaration to be complete. See 37 CFR 1.51(b)(2). The continued prosecution application interim rule amends 37 CFR 1.53(d)(1)(ii) to permit the filing of a continued prosecution application even if the prior nonprovisional application does not contain the inventor's oath or declaration so long as the continued prosecution application is filed on or after September 16, 2012, and the prior nonprovisional application contains an

application data sheet indicating the name, residence, and mailing address of each inventor. This change avoids the need for applicants to file the inventor's oath or declaration in an application in order to file a continued prosecution application of that application. This final rule adopts as final the amendments to the rules of practice originally set forth in the continued prosecution application interim rule.

Discussion of Specific Rules

The continued prosecution application interim rule published on March 5, 2014, amended § 1.53(d)(1)(ii) to change “[t]he prior nonprovisional application is a design application that is complete as defined by §1.51(b)” to “[t]he prior nonprovisional application is a design application that is complete as defined by § 1.51(b), except for the inventor's oath or declaration if the application is filed on or after September 16, 2012, and the prior nonprovisional application contains an application data sheet meeting the conditions specified in § 1.53(f)(3)(i).”

Comments: The Office received no comments in response to the continued prosecution application interim rule.

Rulemaking Considerations:

A. Administrative Procedure Act: This final rule simply adopts as final changes in the continued prosecution application interim rule, which pertain to the procedures that apply

to the filing of a continued prosecution application and do not change the substantive criteria of patentability. Therefore, the changes in this rulemaking involve rules of agency practice and procedure, and/or interpretive rules. See JEM Broad. Co. v. FCC, 22 F.3d 320, 326 (D.C. Cir. 1994) (“[T]he critical feature of the procedural exception [in 5 U.S.C. 553(b)(A)] is that it covers agency actions that do not themselves alter the rights or interests of parties, although [they] may alter the manner in which the parties present themselves or their viewpoints to the agency”) (quoting Batterton v. Marshall, 648 F.2d 694, 707 (D.C. Cir. 1980)); see also Bachow Commc’ns Inc. v. FCC, 237 F.3d 683, 690 (D.C. Cir. 2001) (rules governing an application process are procedural under the Administrative Procedure Act); Inova Alexandria Hosp. v. Shalala, 244 F.3d 342, 350 (4th Cir. 2001) (rules for handling appeals were procedural where they did not change the substantive standard for reviewing claims).

In addition, the Office, pursuant to authority at 5 U.S.C. 553(b)(3)(B), found good cause to adopt the changes in the continued prosecution application interim rule without prior notice and an opportunity for public comment, as such procedures would have been contrary to the public interest. Delay in the promulgation of the changes in the continued prosecution application interim rule to provide notice and comment procedures would have caused harm to those applicants who file a continued prosecution application where the prior nonprovisional application does not contain the inventor’s oath or declaration. Immediate implementation of the changes in the continued prosecution application interim rule was in the public interest because: (1) the public did not need time to

conform its conduct as the changes in the continued prosecution application interim rule merely eased the requirements for filing a continued prosecution application; and (2) those applicants who were ineligible to file a continued prosecution application because the prior nonprovisional application does not contain the inventor's oath or declaration benefitted from the changes in the continued prosecution application interim rule. See Nat'l Customs Brokers & Forwarders Ass'n v. U.S., 59 F.3d 1219, 1223–24 (Fed. Cir. 1995).

Accordingly, prior notice and opportunity for public comment was not required pursuant to 5 U.S.C. 553(b) or (c), 35 U.S.C. 2(b)(2)(B), or any other law. See Cooper Techs. Co. v. Dudas, 536 F.3d 1330, 1336–37 (Fed. Cir. 2008) (stating that 5 U.S.C. 553, and thus 35 U.S.C. 2(b)(2)(B), does not require notice and comment rulemaking for “interpretative rules, general statements of policy, or rules of agency organization, procedure, or practice”) (quoting 5 U.S.C. 553(b)(A)). In addition, pursuant to authority at 5 U.S.C. 553(d)(1), the changes in the continued prosecution application interim rule were made immediately effective because they relieved restrictions in the requirements for filing a continued prosecution application.

B. Regulatory Flexibility Act: As prior notice and an opportunity for public comment are not required pursuant to 5 U.S.C. 553 or any other law, neither a regulatory flexibility analysis nor a certification under the Regulatory Flexibility Act (5 U.S.C. 601 et seq.) is required. See 5 U.S.C. 603.

C. Executive Order 12866 (Regulatory Planning and Review): This rulemaking has been determined to be not significant for purposes of Executive Order 12866 (Sept. 30, 1993).

D. Executive Order 13563 (Improving Regulation and Regulatory Review): The Office has complied with Executive Order 13563. Specifically, the Office has, to the extent feasible and applicable: (1) made a reasoned determination that the benefits justify the costs of the rule; (2) tailored the rule to impose the least burden on society consistent with obtaining the regulatory objectives; (3) selected a regulatory approach that maximizes net benefits; (4) specified performance objectives; (5) identified and assessed available alternatives; (6) involved the public in an open exchange of information and perspectives among experts in relevant disciplines, affected stakeholders in the private sector and the public as a whole, and provided on-line access to the rulemaking docket; (7) attempted to promote coordination, simplification, and harmonization across government agencies and identified goals designed to promote innovation; (8) considered approaches that reduce burdens and maintain flexibility and freedom of choice for the public; and (9) ensured the objectivity of scientific and technological information and processes.

E. Executive Order 13132 (Federalism): This rulemaking does not contain policies with federalism implications sufficient to warrant preparation of a Federalism Assessment under Executive Order 13132 (Aug. 4, 1999).

F. Executive Order 13175 (Tribal Consultation): This rulemaking will not: (1) have substantial direct effects on one or more Indian tribes; (2) impose substantial direct compliance costs on Indian tribal governments; or (3) preempt tribal law. Therefore, a tribal summary impact statement is not required under Executive Order 13175 (Nov. 6, 2000).

G. Executive Order 13211 (Energy Effects): This rulemaking is not a significant energy action under Executive Order 13211 because this rulemaking is not likely to have a significant adverse effect on the supply, distribution, or use of energy. Therefore, a Statement of Energy Effects is not required under Executive Order 13211 (May 18, 2001).

H. Executive Order 12988 (Civil Justice Reform): This rulemaking meets applicable standards to minimize litigation, eliminate ambiguity, and reduce burden as set forth in sections 3(a) and 3(b)(2) of Executive Order 12988 (Feb. 5, 1996).

I. Executive Order 13045 (Protection of Children): This rulemaking does not concern an environmental risk to health or safety that may disproportionately affect children under Executive Order 13045 (Apr. 21, 1997).

J. Executive Order 12630 (Taking of Private Property): This rulemaking will not affect a taking of private property or otherwise have taking implications under Executive Order 12630 (Mar. 15, 1988).

K. Congressional Review Act: Under the Congressional Review Act provisions of the Small Business Regulatory Enforcement Fairness Act of 1996 (5 U.S.C. 801 et seq.), prior to issuing any final rule, the United States Patent and Trademark Office will submit a report containing the rule and other required information to the United States Senate, the United States House of Representatives, and the Comptroller General of the Government Accountability Office. The changes in this final rule are not expected to result in an annual effect on the economy of 100 million dollars or more, a major increase in costs or prices, or significant adverse effects on competition, employment, investment, productivity, innovation, or the ability of United States-based enterprises to compete with foreign-based enterprises in domestic and export markets. Therefore, this final rule is not a “major rule” as defined in 5 U.S.C. 804(2).

L. Unfunded Mandates Reform Act of 1995: The changes set forth in this notice do not involve a Federal intergovernmental mandate that will result in the expenditure by

State, local, and tribal governments, in the aggregate, of 100 million dollars (as adjusted) or more in any one year, or a Federal private sector mandate that will result in the expenditure by the private sector of 100 million dollars (as adjusted) or more in any one year, and will not significantly or uniquely affect small governments. Therefore, no actions are necessary under the provisions of the Unfunded Mandates Reform Act of 1995. See 2 U.S.C. 1501 et seq.

M. National Environmental Policy Act: This rulemaking will not have any effect on the quality of the environment and is thus categorically excluded from review under the National Environmental Policy Act of 1969. See 42 U.S.C. 4321 et seq.

N. National Technology Transfer and Advancement Act: The requirements of section 12(d) of the National Technology Transfer and Advancement Act of 1995 (15 U.S.C. 272 note) are not applicable because this rulemaking does not contain provisions which involve the use of technical standards.

O. Paperwork Reduction Act: The Paperwork Reduction Act of 1995 (44 U.S.C. 3501 et seq.) requires that the Office consider the impact of paperwork and other information collection burdens imposed on the public. This final rule involves information collection requirements which are subject to review by the Office of Management and Budget (OMB) under the Paperwork Reduction Act of 1995 (44 U.S.C. 3501-3549). This

rulemaking does not impose any additional collection requirements under the Paperwork Reduction Act which are subject to further review by OMB.

Notwithstanding any other provision of law, no person is required to respond to, nor shall a person be subject to a penalty for failure to comply with, a collection of information subject to the requirements of the Paperwork Reduction Act unless that collection of information displays a currently valid OMB control number.

List of Subjects in 37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and recordkeeping requirements, Small Businesses.

For the reasons set forth in the preamble, the interim rule amending 37 CFR part 1 which was published at 79 FR 12384—12386 on March 5, 2014, is adopted as a final rule without change.

Dated: November 6, 2014.

Michelle K. Lee,
*Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office.*

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